

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 8, 2005 ("*Office Action*"). Claims 1-25, 46-70, and 88-92 were pending in the Application and stand rejected. Applicants amend Claims 1-7, 15-16, 18-19, 21-22, 24, 46, 48-53, 61-62, 64-65, 67-69, 88 and 91 to advance prosecution. Applicants respectfully request reconsideration and favorable action in this case.

Amended Claims 1-25, 46-70, and 88-92 are Allowable.

The Examiner rejects independent Claims 1 and 46 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,862,490 to Sasuta et al. ("*Sasuta*").

The Examiner rejects all other pending claims, Claims 2-25, 47-70, and 88-92 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of references, including (a) *Sasuta*; (b) U.S. Patent 5,301,359 to Van den Heuvel et al. ("*Van den Heuvel*"); (c) U.S. Patent 5,581,802 to Erickson et al. ("*Erickson*"); (d) U.S. Patent 6,064,972 to Jankowitz ("*Jankowitz*"); (e) U.S. Patent 5,961,569 to Craport et al. ("*Craport*"); and (f) U.S. Patent 6,424,646 to Gerszberg et al. ("*Gerszberg*").

A. The Cited References, Alone or in Combination, Fail to Teach or Suggest the Limitations Recited in the Amended Claims.

Applicants respectfully submit that amended Claims 1-25, 46-70, and 88-92 are allowable at least because the cited references, alone or in combination, fail to teach or suggest each and every element of Claims 1-25, 46-70, and 88-92.

For example, amended Claim 1 recites:

A method for brokering resources of a wireless communications network, comprising:

providing a service interface allowing a user of a remote communications device to select one or more geographic regions for which the user desires wireless service coverage for the remote communications device;

receiving at a centralized brokerage manager via the service interface a request from the user for a wireless service at a particular geographic region selected by the user via the service interface;

selectively determining an availability of the wireless service for at least two service providers available at the selected geographic region based on the request;

generating a first response to the request based on the availability of the wireless service at the selected geographic region, the first response including one or more terms for the wireless service including at least one option between the at least two service providers;

communicating the first response to the remote communications device; and

receiving a second response to the first response, the second response selecting at least one of the at least two service providers to provide the wireless service.

Among other elements, the cited references, alone or in combination, fail to teach or suggest:

- providing a service interface allowing a user of a remote communications device to select one or more geographic regions for which the user desires wireless service coverage for the remote communications device;

- receiving at a centralized brokerage manager via the service interface a request from the user for a wireless service at a particular geographic region selected by the user via the service interface; [and]

- selectively determining an availability of the wireless service for at least two service providers available at the selected geographic region based on the request; (emphasis added)

For example, *Sasuta* teaches a system for providing communication services to mobile units that each have one or more communication service requirements. A mobile unit catalogues service attributes for each of multiple service providers so that a determination can be made as to which service providers are necessary to meet the mobile unit's service requirements. (Col. 2, lines 35-46). For each of the one or more service requirements of a mobile unit (e.g., telephone, fax, data, or video service requirements), one of the multiple service providers is selected concurrently in order to facilitate that service requirement. (Col. 2, lines 46-49). Thus, according to *Sasuta*, each service provider does not need to provide all types of service capabilities, and mobile users may receive different services from different service providers in a cost efficient manner. (Col. 2, lines 49-56).

Sasuta fails to teach or suggest “providing a service interface allowing a user of a remote communications device to select one or more geographic regions for which the user desires wireless service coverage for the remote communications device,” as recited in amended Claim 1. In fact, *Sasuta* discloses nothing related to a mobile user selecting a geographic region for which the user desired wireless service coverage, much less providing an interface allowing a user to select such a desired geographic coverage area.

Van den Heuvel teaches a bulletin board communication resource that provides a message to communication units regarding available communication systems in a particular geographic area. (Abstract). The bulletin board resource allows a communication unit to register with one or more communication systems selected by the communication unit. (Abstract). More particularly, a bulletin board controller (206) transmits on a bulletin board outbound communication resource, such as a dedicated RF frequency. (Col. 3, lines 37-40). This outbound bulletin board resource includes a periodic transmission of a menu message (501) from the bulletin board controller (206). (Col. 3, lines 53-55). The menu message (501) includes information regarding available communication systems, such as information regarding identification of the service itself (i.e., wide area paging service, SMR service, on-site service, cellular service, encrypted voice service, data capability, community repeater access, and the like), control resource information and/or specific interface protocols (if any), cost information, etc. (Col. 3, line 56 - Col. 4, line 2).

A communication unit (104), upon locating the outbound bulletin board resource, receives the menu message (501) and processes it to recover the above indicated information. (Col. 4, lines 3-6). The communication unit (104) can then allow selection of one or more of the available services, which selection generates and sends a registration request message (502) on a bulletin board inbound resource that is associated with the bulletin board outbound resource. (Col. 4, lines 6-17).

The bulletin board controller (206) receives the registration request (502), registers the communication unit (104) with the communication systems selected by the communication unit (104), and sends a message to the communication unit (104) indicating that the requested communication system access has been granted. (Col. 4, lines 18-26). The communication unit (104) can then select the transceiver appropriate to the system and

service selected, and begin operation as a communication entity within the selected system using the information provided by the bulletin board resource. (Col. 4, lines 27-31).

If desired, the communication unit (104) can occasionally use its unselected transceivers to briefly monitor other available systems, the identities of which are known to the communication unit (104) due to the menu message (501). (Col. 4, lines 32-36). Thus, the communication unit (104) can occasionally determine the availability status, due to its geographic location, of the various systems located within the geographic area governed by the bulletin board controller (206). (Col. 4, lines 36-40). With this information, the communication unit (104) can alter its own system status as more desired systems become available due to movement of the communication system (104) throughout the area. (Col. 4, lines 40-45).

Thus, *Van den Heuvel* does not teach or suggest a user of a communication unit (104) selecting a geographic region for which the user desires wireless service coverage, much less providing an interface allowing a user to select such a desired geographic region for wireless coverage. Thus, *Van den Heuvel* fails to teach or suggest “providing a service interface allowing a user of a remote communications device to select one or more geographic regions for which the user desires wireless service coverage for the remote communications device,” as recited in amended Claim 1.

Similarly, each of the other references cited in the *Office Action* - namely, *Jankowitz*, *Craport*, and *Gerszberg* - fail to teach or suggest at least “providing a service interface allowing a user of a remote communications device to select one or more geographic regions for which the user desires wireless service coverage for the remote communications device,” as recited in amended Claim 1.

For at least these reasons, Applicants respectfully request reconsideration and allowance of amended independent Claim 1, together with Claims 2-25 that depend from therefrom. In addition, for analogous reasons, Applicants respectfully request reconsideration and allowance of amended independent Claims 46 and 88, together with Claims 47-70 and 89-92 that depend from Claims 46 and 88.

B. There is No Teaching, Suggestion, or Motivation to Combine or Modify the Teachings of the References.

Furthermore, Applicants maintain their previously presented arguments regarding the lack of teaching, suggestion or motivation to combine or modify the references to teach or suggest Applicants' claimed subject matter, which arguments are repeated below.

Applicants respectfully submit that Claims 1-25, 46-70, and 88-92 are patentable over the cited references because there is no teaching, suggestion, or motivation to combine or modify the teachings of the references either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Moreover, the *Office Action* fails to point to any evidence sufficient to show a *prima facie* case of obviousness.

The M.P.E.P. sets forth a strict legal standard for combining or modifying references. According to the M.P.E.P., "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. "The mere fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification. *Id.* (emphasis in original).

Governing Federal Circuit case law makes this strict legal standard even clearer. According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation . . . is an 'essential component of an obviousness holding.'" *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)). Furthermore, while "evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved, . . . [t]he range of sources available . . . does not diminish the requirement for actual evidence." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, it is a factual question that cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). Indeed, the factual inquiry whether to combine or modify references must be

thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001).

1. Claims 1-15, 19, 20, 24, 25, 46, 48-61, 65, 66, 69, and 70.

The Examiner rejects Claims 1-15, 19, 20, 24, 25, 46, 48-61, 65, 66, 69, and 70 under 35 U.S.C. § 103(a) as being unpatentable over *Van den Heuvel* in view of *Grube* and *Rahman*.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Van den Heuvel*, *Grube*, and *Rahman*. Instead, the *Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference. For example, with regard to independent Claim 1 the *Office Action* first states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Grube to said method of Van den Heuvel in order to better alternate wireless services based on geographic region.

Office Action, pages 2-3. Then, the *Office Action* states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Rahman to said method of Van den Heuvel in order to better ensure that the mobile subscriber receives the lowest cost wireless service.

Office Action, page 3. The exact same language is used in the *Office Action* with regard to independent Claim 46 on pages 4 and 5.

Applicants respectfully submit that these statements do not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. These statements represent the subjective belief of the Examiner, do not point to any known authority, and therefore are not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 1-15, 19, 20, 24, 25, 46, 48-61, 65, 66, 69, and 70 are allowable over the cited references.

2. Claims 88-90.

The Examiner rejects Claims 88-90 under 35 U.S.C. § 103(a) as being unpatentable over Van den Heuvel in view of Erickson and Rahman.

In the present case, the Office Action has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of Van den Heuvel, Erickson, and Rahman. Instead, the Office Action has merely stated that the teachings of one reference would improve the teachings of another reference. For example, with regard to independent Claim 88 the Office Action first states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Erickson to said method of Van den Heuvel in order to reduce multiple requests being made before access to a wireless service is gained.

Office Action, page 8. Then, the *Office Action* states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Rahman to said method of Van den Heuvel in order to better ensure that the mobile subscriber receives the lowest cost wireless service.

Office Action, page 9.

Applicants respectfully submit that these statements do not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. These statements represent the subjective belief of the Examiner, do not point to any known authority, and therefore are not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 88-90 are allowable over the cited references.

3. Claims 16, 17, 62, and 63.

The Examiner rejects Claims 16, 17, 62, and 63 under 35 U.S.C. § 103(a) as being unpatentable over *Van den Heuvel*, *Rahman*, and *Grube* in view of *Jankowitz*.

In the present case, the Office Action has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Van den Heuvel*, *Rahman*, *Grube*, and *Jankowitz*. Instead, the Office Action has merely stated that the teachings of one reference would improve the teachings of another reference. For example, the Office Action states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Jankowitz to said method of Van den Heuvel in order to expand the number of resources available to a user to provide the best service.

Office Action, page 10.

Applicants respectfully submit that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 16, 17, 62, and 63 are allowable over the cited references.

4. Claims 18, 21, 47, 64, 67, and 91.

The Examiner rejects Claims 18, 21, 47, 64, 67, and 91 under 35 U.S.C. § 103(a) as being unpatentable over *Van den Heuvel*, *Grube*, *Erickson*, *Rahman*, and *Jankowitz* in view of *Craport*.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Van den Heuvel*, *Grube*, *Erickson*, *Rahman*, *Jankowitz*, and *Craport*. Instead, the *Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference. For example, the *Office Action* first states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of *Craport* to said method of *Van den Heuvel* in order to make it easier for the user to obtain the best available wireless service.

Office Action, pages 10-11. Then, the *Office Action* states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of *Rahman* to said method of *Van den Heuvel* in order to make it easier for the user to obtain and later select the best available wireless service.

Office Action, page 11.

Applicants respectfully submit that these statements do not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. These statements represent the subjective belief of the Examiner, do not point to any known authority, and therefore are not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 18, 21, 47, 64, 67, and 91 are allowable over the cited references.

5. Claims 22, 23, 68, and 92.

The Examiner rejects Claims 22, 23, 68, and 92 under 35 U.S.C. § 103(a) as being unpatentable over *Van den Heuvel, Grube, Rahman, and Erickson* in view of *Gerszberg*.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Van den Heuvel, Grube, Rahman, Erickson, and Gerszberg*. Instead, the *Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference. For example, the *Office Action* states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Gerszerg to said method of Van den Heuvel in order to make it easier for the user to obtain and select the best available wireless service.

Office Action, page 11.

Applicants respectfully submit that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 22, 23, 68, and 92 are allowable over the cited references.

C. The Proposed Modification or Combination of References Would Impermissibly Change the Principle of Operation of the References.

In addition, Applicants maintain their previously presented arguments regarding the fact that the Claims 1-25, 46-70, and 88-92 are patentable over the cited references because the proposed combination of references would impermissibly change the principle of operation of the references, which arguments are repeated below.

To render the claims *prima facie* obvious, a proposed modification or combination of references must not change the principle of operation of the reference or references being modified. M.P.E.P. §2143.01.

Each rejection relies at least in part on a proposed modification or combination of *Van den Heuvel* and *Rahman*. However, the proposed modification of *Van den Heuvel* based on *Rahman* would improperly change *Van den Heuvel*'s principle of operation. The operation of *Van den Heuvel* requires a bulletin board resource to periodically transmit a single menu message including information regarding available communications systems. *Van den Heuvel*, Col. 3, lines 53-57. *Van den Heuvel* makes clear that the single menu message is transmitted from "time-to-time" and not in response to any inquiry. *Id.* Furthermore, the menu message is sent by a centralized bulletin board resource and not each communication system. *Id.* The mode of operation disclosed in *Van den Heuvel* insulates individual communications systems and provides for efficient communications by avoiding redundancies. Modifying *Van den Heuvel* so that multiple individual candidate service providers each transmits its own tariff charge in response to individual inquiries, as taught by *Rahman*, would not only change the principle of operation disclosed by *Van den Heuvel*, but the benefits of utilizing a centralized bulletin board resource would also be lost. Thus, Applicants respectfully submit that the proposed modification is improper.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 1-25, 46-70, and 88-92 are allowable over the cited references.

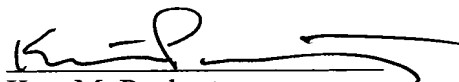
Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

No fees are believed to be due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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